



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,403	04/23/2001	David J. Boothby	05110-009003	5942

7590 06/17/2002
G. ROGER LEE
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

EXAMINER

HOMERE, JEAN RAYMOND

ART UNIT	PAPER NUMBER
----------	--------------

2177

DATE MAILED: 06/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/840,403

Applicant(s)
Boothby et al.

Examiner
Jean R. Homere

Art Unit
2177



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/26/01
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application
- 4a) Of the above, claim(s) none is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other: _____

Art Unit: 2177

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,044,381.

Although the conflicting claims are not identical, they are not patentably distinct from each

Art Unit: 2177

other because it would have been obvious to one of ordinary skill in the art of data processing to omit from the independent claims of the cited the patent the steps of :

- 1) 'storing a second historical file on the second computer containing records representative of records of the first database at the completion of the previous synchronization, wherein one of the representative records represents the record of the first database determined to be unchanged;'
- 2) 'using the information identifying the unchanged record to locate the one of the representative records in the second history file;' and
- 3) performing a synchronization, at the second computer, of the second and first databases using the one of the representative records.'

It would have been obvious to one of ordinary skill in the art of data processing to omit the cited steps from the method for synchronizing a first and second databases as recited in claims 1 and 14 of the cited patent. Such an omission would streamline and simplify the synchronization process of the databases, as presently claimed in the instant application.

2a. The dependent claims in the instant application recite identical limitation to those in the cited patent. Therefore, they are rejected under the same double patenting as set forth above.

Information Disclosure Statement

3. The information disclosure statement (IDS) filed on 08/09/2001 complies with the provisions of MPEP § 609 . It has been placed in the application file, the information referred to therein has been considered as to the merits.

Art Unit: 2177

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Alley et al. ('Alley', hereinafter), US Patent no.5,710,922, submitted by applicants in IDS, paper no.7

Art Unit: 2177

As to claim 1, Alley discloses a method for synchronizing and archiving information between computer systems (col.1, lines 1-3, et seq). In particular, the method includes the step of identifying each record in a first computer to be synchronized through a unique identification indicia, indicating the last time the record was altered (col.2, lines 4-9, et seq). In addition, each selected record that was added to the first computer since the last synchronization are identified and copied to the second computer (col.2, lines 19-23, et seq). Further, each selected record in the first computer that was modified since the last synchronization is identified and synchronized (col.2, lines 23-27, et seq). The reader should duly note that by identifying records that were modified in the first computer to update corresponding records in a second computer since the last synchronization, the system inherently synchronize the second computer records with the first by updating corresponding unmodified records that were identified in the second computer.

As to claim 2, Alley discloses a synchronization list for identifying each of the selected records that was added or deleted on the first or second computer since the last synchronization (col.2, lines 55-67, et seq)

As to claim 3, Alley discloses the transfer of data records from a first computer to a second computer in order locate and update corresponding records in the second computer (col.2, lines 13-23, et seq).

Art Unit: 2177

As to claims 4-5, Alley discloses a synchronization list containing unique indicia for identifying records in the first computer to be synchronized in the second computer (col.2, lines 31-38; line 55-67, et seq).

8. The limitations of claims 6-34 have already been discussed in the rejection of claims 1-6 above. They are therefore rejected on similar grounds.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-1449.

Art Unit: 2177

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean R. Homere whose telephone number is (703)-308-6647. The examiner can normally be reached on Monday-Friday from 09:30 a.m.-6:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on Monday-Friday from 8:00 a.m. to 3:30 p.m. at (703)-305-9790.

Any response to this action should be mailed to: Commissioner of Patents and Trademarks Washington, D.C. 20231, **or faxed to:** (703) 746-7239, (for formal communications intended for entry), **or faxed to:** (703) 746-7238, (for after final communications intended for entry), **Or:** (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Jean R. Homere

Jean R. Homere
Primary Examiner, A.U. 2177
June 12, 2002